

Application No. 10/634,994
Amendment dated March 21, 2005
Reply to Office Action of February 4, 2005

REMARKS

Allowable Claims

Applicants gratefully acknowledge that claims 9-12 have been allowed. Dependent claims 10-12 have been amended for clarification.

As to claim 10, the recitation “the green soybean is cultivated with an interval of 11 cm or more between roots” is supported in the specification at page 16 et seq., “Example 2”, specifically page 16, line 20 and page 18, lines 9-14. The specification explains as follows:

Because the root interval is highly related to the luminous intensity of light, **the enlarged root interval increases the luminous intensity of light**, and the increased speed of photosynthesis promotes production of chloroplasts, thereby inducing an increase of the contents of both chlorophyll and β-carotene. Consequently, the green color of pods of the green soybeans is retained for a relatively long time.

It is clear for a person of ordinary skill in the art that the interval need not be limited in the range of 11-13 cm.

The allowed claim recitation “the green soybean is to widen an interval between roots” itself was supporting the recitation without upper limit. Also, MPEP 2106 B 1 explains as follows:

For the written description requirement, an applicant’s specification must reasonably convey to those skilled in the art that the applicant was in possession of the claimed invention as of the date of invention. *Regents of the University of California v. Eli Lilly & Co.*, 119 F.3d 1559, 1568, 43 USPQ2d 1398, 1405 (Fed. Cir. 1997); *Hyatt v. Boone*, 146 F.3d 1348, 1354, 47 USPQ2d 1128, 1132 (Fed. Cir. 1998). The claimed invention subject matter need not be described literally, i.e., using the same terms, in order for the disclosure to satisfy the description requirement. Software aspects of inventions may be described functionally. See *Robotic Vision Sys. v. View Eng’g, Inc.*, 112 F.3d 1163, 1166, 42 USPQ2d 1619, 1622-23 (Fed. Cir. 1997); *Fonar Corp. v. General*

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Electric Co., 107 F.3d 1543, 1549, 41 USPQ2d 1801, 1805 (Fed. Cir. 1997); *In re Hayes Microcomputer Prods., Inc.*, 982 F.2d 1527, 1537-38, 25 USPQ2d 1241, 1248-49 (Fed. Cir. 1992).

Rejections under 35 USC §103(a)

- Claims 1-8 are rejected under 35 USC §103(a) as being obvious over Applicants' admitted prior art (Table 4) in view of either one of US Soyfoods Directory or JP 8-242799.

The Examiner alleged as follows:

Applicants also admit via Table 4 that the product of Control Group 1 sets forth a green soybean having a chlorophyll a content of 3.7 plus or minus 0.04 g per grams of wet weight as opposed to instant claim 1 calling for green soybean with a chlorophyll a content of not less than 3.8 g/100 g wet weight. It is not seen where the difference between same would make for a patentable distinction as the amount of chlorophyll between Control Group 1 and the lower limit of the range set forth in claim 1 is so extremely close.

Independent claim 1 has been amended to recite "selecting a green soybean containing chlorophyll a of not less than 3.93 g/100 g wet weight, or using a green soybean cultivated to contain chlorophyll a of not less than 3.93 g/100 g wet weight." The recitation "not less than 4.0 g/100 g wet weight" is supported by Inventive Group 2 in Table 4.

The recitation "not less than 3.93 g/100 g wet weight" makes a patentable distinction from Control Group 1 in Table 4.

Thus, the cited references, taken alone or in combination, do not teach or suggest "selecting a green soybean containing chlorophyll a of not less than 3.93 g/100 g wet weight, or using a green soybean cultivated to contain chlorophyll a of not less than 3.93 g/100 g wet weight."

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For at least these reasons, claim 1 patentably distinguishes over the cited references. Claims 2-4, depending from claim 1, also patentably distinguish over the cited references for at least the same reasons.

Regarding claim 5, the Examiner similarly alleged on beta-carotene referring to Control Group 11.

Independent claim 5 has been amended to recite “selecting a green soybean containing β -carotene of not less than 846.6 $\mu\text{g} / 100 \text{ g}$ wet weight, or using a green soybean cultivated to contain β -carotene of not less than 846.6 $\mu\text{g} / 100 \text{ g}$ wet weight.”

The recitation “ β -carotene of not less than 846.6 $\mu\text{g} / 100 \text{ g}$ wet weight” is also supported by Inventive Group 2 in Table 4. The recitation “not less than 846.6 $\mu\text{g} / 100 \text{ g}$ wet weigh” makes a patentable distinction from Control Group 11 in Table 4.

Thus, the cited references, taken alone or in combination, do not teach or suggest “selecting a green soybean containing β -carotene of not less than 846.6 $\mu\text{g} / 100 \text{ g}$ wet weight, or using a green soybean cultivated to contain β -carotene of not less than 846.6 $\mu\text{g} / 100 \text{ g}$ wet weight.”

For at least these reasons, claim 5 patentably distinguishes over the cited references. Claims 6-8, depending from claim 5, also patentably distinguish over the cited references for at least the same reasons.

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New Claims

New claims recites the step of “preserving said green soybean under illumination of light for 24 hours or more.” Nothing in the prior art teaches or suggest the recitation.

In view of the aforementioned amendments and accompanying remarks, Applicants submit that the claims, as herein amended, are in condition for allowance. Applicants request such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants’ undersigned attorney to arrange for an interview to expedite the disposition of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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